

**REMARKS**

The present application includes claims 16-20, 22, 103, and 105-127. By this Amendment, claims 16 and 145 have been amended. The Examiner is requested to reconsider the application.

In paragraphs 4-5 of the Office Action, the Examiner has rejected claims 16-20, 22, 103, and 105-151 pursuant to 35 U.S.C. Sec. 112, first paragraph. The Examiner contends that these claims are based on a disclosure which is not enabling and that the claims contain subject matter that is not described in the specification in such a way as to enable one skilled in the art to make or use the invention, for reasons more fully set forth in the Office Action. This contention is respectfully traversed, as set forth below.

First, the Examiner contends (in paragraph 4 of the Office Action) that the instant messaging server, an instant messaging database, and authorization database and a profile database are all critical or essential to the practice of the invention but not included in the claim.

In response, the contention is respectfully traversed. The Examiner is directed to MPEP Section 2164, which provides, in relevant part:

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an

allegedly critical feature, tends to rebut the argument of criticality.  
(Emphasis Added)

Neither the specification nor the declarations impose "criticality," and the specification includes such "broad language." Further, pursuant to 35 U.S.C. Sec. 132, Applicant respectfully requests a more particular explanation and information as to why the cited apparatus limitations are essential elements in the method claims.

Second, the Examiner contends (in paragraph 5 of the Office Action) that the rejected claims are non-enabled because undue experimentation is required. The Examiner admits, at Pages 3-4 of the Office Action, that the proper test for enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue.

Further, the Examiner is directed to MPEP Section 2164, which provides, in relevant part:

In computer applications, it is not unusual for the claimed invention to involve two areas of prior art or more than one technology, e.g., an appropriately programmed computer and an area of application of said computer. *White Consol. Indus. v. Vega Servo- Control, Inc.*, 214 USPQ 796, 821 (S.D.Mich. 1982). In regard to the "skilled in the art" standard, in cases involving both the art of computer programming, and another technology, the examiner must recognize that the knowledge of persons skilled in both technologies is the appropriate criteria for determining sufficiency. See *In re Naquin*, 398 F.2d 863, 158 USPQ 317 (CCPA 1968); *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *White Consol. Indus.*, 214 USPQ at 822, *aff'd* on related grounds, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983).

Where different arts are involved in the invention, the specification is enabling if it enables persons skilled in each art to carry out the aspect of the invention applicable to their specialty. *In re Naquin*, 398 F.2d 863, 866, 158 USPQ 317, 319 (CCPA 1968). When an invention, in its different aspects, involves distinct arts, the specification is enabling if it enables those skilled in each art, to carry out the aspect proper to their

specialty. "If two distinct technologies are relevant to an invention, then the disclosure will be adequate if a person of ordinary skill in each of the two technologies could practice the invention from the disclosures." Technicon Instruments Corp. v. Alpkem Corp., 664F. Supp. 1558, 1578, 2 USPQ2d 1729, 1742 (D. Ore. 1986), *aff'd in part, vacated in part, rev'd in part*, 837 F. 2d 1097 (Fed. Cir. 1987) (unpublished opinion), appeal after remand, 866 F. 2d 417, 9 USPQ 2d 1540 (Fed. Cir. 1989). In *Ex parte Zechnall*, 194 USPQ 461 (Bd. App. 1973), the Board stated "appellants' disclosure must be held sufficient if it would enable a person skilled in the electronic computer art, in cooperation with a person skilled in the fuel injection art, to make and use appellants' invention." 194 USPQ at 461. (Emphasis Added)

Consequently, the proper test for enablement is NOT whether a person skilled in the art of instant messaging would have been able to implement the encryption aspects recited in the present claims, but whether a person skilled in the arts of both instant messaging AND encryption would have been able to implement the claimed limitations. The Examiner has not addressed this contention. Consequently, based on the evidence and controlling law, it is respectfully submitted that the Examiner has not established a prima facie case of lack of enablement under Sec. 112.

Prior to paragraph 6 of the Office Action, the Examiner has made a citation to 35 U.S.C. Sec. 102(e) but has made no rejection. That is, in paragraph 7 of the Office Action, claims 112 and 113 have been "rejected pursuant to 35 U.S.C. Sec. 103(a) as being anticipated" by Auerbach. Intermediate paragraph 6 of the Office Action does not lend clarity as to the statutory basis for the rejection. Where one cannot determine the statutory basis for a rejection, the rejection is defective pursuant to 35 U.S.C. Sec. 132.

Final rejection is inappropriate where Applicant has had no opportunity to respond without clear notice of the statutory basis for a rejection.

As regards paragraphs 8-9 of the Office Action, Examiner contends, at page 13, that “Auerbach’s conversion platform is analogous to Applicant’s claimed database,” and at page 9 “the Office interprets Auerbach’s protocol conversion platform as Applicant’s database.”

Analogous” is not a standard for withholding a patent under either Sec. 102 or Sec. 103. Further, Professor Hollaar’s declaration is entitled to weight as to the factual basis for the Examiner’s “analogous” contention and the factual basis for the Examiner’s “interpretation,” as well as lack of reason to modify to reach Applicant’s claimed invention, if the rejection be under Sec. 103. In any case, the rejection is defective for failing to clearly indicate its statutory basis, and also because Auerbach does not teach retrieving... from a database accessible to the first user according to the requirements of claims 112 and 113. A *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 10-17 of the Office Action, the Examiner has rejected claims 16-20, 22, 103, and 105-111, 118-121, and 125-127 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Aramundan in view of Gudjonsson.

In response, the rejection is respectfully traversed. As to claims 16-20, 22, 103, and 105-111, the base claim 16 has been amended such that the rejection is moot. As regards claims 16-20, 22, 103, and 105-111, 118-121, and 125-127, Applicant relies on the declarations. Note Professor Hollaar's declaration is entitled to weight as to the factual basis for the Examiner's "analogous" contentions, and "analogous" is not a standard for withholding a patent. Further, the rejections mischaracterize the references rather than show prior art disclosures of the particular claim requirements. Also, the Examiner's claim interpretation is not reasonable or proper, at least because as between does not mean "between", and all claim limitations must be considered.

As to the Examiner's reliance on U.S. Patent No. 6,564,261 (Gudjosson), Applicant maintains that the Gudjosson patent does not qualify as prior art with regard to the specific limitations cited in the claims. More specifically, the Examiner apparently acknowledges that the test for whether a reference qualifies as prior art is the date on which the subject matter is disclosed. The Examiner also apparently realizes that the filing date of the Gudjosson patent is late enough so that the Gudjosson patent, on its own, can not serve as prior art. However, the Examiner attempts to rely on the recitation of subject matter in the provisional patent application to establish an earlier date for Gudjosson to allow Gudjosson to be prior art.

However, when the Examiner actually rejects the claims, the Examiner makes the rejections based on disclosure in the patent rather than in the provisional patent application, as is required. That is, the Examiner fails to match the specific claim

limitations to the specific disclosure of subject matter in the provisional patent application as required.

In other words, the wording between the Gudjosson patent and the Gudjosson provisional application are not the same, and thus the disclosures are not the same, and thus the Examiner must rely on the provisional patent application to precisely establish what was known prior Applicant's filing date. The Examiner has, at page 8, pointed to portions of the provisional application that the Examiner contends support portions of the patent, but the wording of the provisional differs from the wording of the patent, and is not mapped to specific claim limitations. Consequently, the rejection is improper as stated, and the rejection must be mapped to, and premised upon, the provisional application rather than the patent.

In sum, a *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 18-20 of the Office Action, the Examiner has rejected claims 114-117 and 122-124 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Aravamundan in view of Shah for reasons set out in the Office Action.

In response, the rejection is respectfully traversed based on the Declaration of Professor Rubin and the Declaration of Professor Hollaar: No proper reason to combine or modify, so as to reach Applicant's claimed invention, has been provided; and the

rejection is premised on a mischaracterization of the references so as not to teach what is contended in the Office Action.

Further, Shah does not disclose Applicant's instant message or as between as claimed.

Consequently, a *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 21-28 of the Office Action, the Examiner has rejected claims 16, 22, 105-108, 118, 122, 125, and 149 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Auerbach, in view of Kim, in further view of U.S. Patent No. 6,564,261 (Gudjosson).

In response, the rejection is respectfully traversed. As to claims 16, 22, 103, and 105-108, the base claim 16 has been amended such that the rejection is moot.

As regards claims 16, 22, 105-108, 118, 122, 125, and 149, Applicant relies on the declarations. Note that Professor Hollaar's declaration is entitled to weight as to the factual basis of the validity of what the Examiner has "interpreted", and "interpreted" is not a standard for withholding a patent. Further, the rejections mischaracterize the references rather than show prior art disclosures of the particular claim requirements. Also, the Examiner's claim interpretation is not reasonable or proper, at least because as between does not mean "between", and all claim limitations must be considered.

Further, as stated above, Gudjosson does not qualify as prior art because the Examiner has not correlated the disclosure of the provisional of Gudjosson with the specific claim limitations and instead improperly cites to the issued Gudjosson patent.

In sum, a *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 29-33 of the Office Action, the Examiner has rejected claims 114-117, and 125 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Auerbach and Kim, in view of Shah.

In response, the rejection is respectfully traversed. Applicant relies on the declarations. Further, the rejections mischaracterize the references rather than show prior art disclosures of the particular claim requirements.

Also, Shah does not disclose Applicant's instant message as claimed, and as to claim 125, does not disclose as between.

A *prima facie* case of obviousness has not been established by the Office Action.

In paragraph 34 of the Office Action, the Examiner has rejected claims 17-20, 103, 123, 124, 126, and 127 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Auerbach, Kim, Gudjonsson, and Appleman, U.S. Pat. No. 6,750,881.

In response the rejection is respectfully traversed. The rejection is defective for lacking the specificity required by 35 U.S.C. Sec. 132. In any case, Applicant relies on the declarations and contests that Gudjosson qualifies as prior art, for the reasons provided above.

A *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 35-44 of the Office Action, the Examiner has rejected claims 128-130, 132-134, 136-146, 150, and 151 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Auerbach in view of Shah.

In response the rejection is respectfully traversed. Applicant relies on the declarations. Note Professor Hollaar's declaration is entitled to weight as to the factual basis for the Examiner's "analogous" contentions, and "analogous" is not a standard for withholding a patent. Further, the rejections mischaracterize the references rather than show prior art disclosures of the particular claim requirements.

Additionally, Shah does not disclose instant messaging and neither reference discloses as between (claims 150-151) as claimed.

A *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 45-46 of the Office Action, the Examiner has rejected claims 131 and 135 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Auerbach and Shah in view of DeSimone.

In response the, rejection is respectfully traversed. Applicant relies on the declarations. Further, the rejections mischaracterize the references rather than show prior art disclosures of the particular claim requirements.

Additionally, Shah does not disclose instant messaging and the references do not disclose as between as claimed.

A *prima facie* case of obviousness has not been established by the Office Action.

In paragraphs 47-49 of the Office Action, the Examiner has rejected claims 147 and 148 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are unpatentable over Auerbach and Shah in view of Avaramudan.

In response the rejection is respectfully traversed. Applicant relies on the declarations. Further, the rejections mischaracterize the references rather than show prior art disclosures of the particular claim requirements.

Additionally, Shah does not disclose instant messaging and the references do not disclose as between as claimed.

A *prima facie* case of obviousness has not been established by the Office Action.

Finally, with respect to the present application claims and this RCE, the Applicant hereby rescinds any disclaimer of claim scope made previously, as directed to the then-pending claims. The Examiner is advised that any previous disclaimer, if any, and the

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prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, be read back into any predecessor or to a related application.

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**CONCLUSION**

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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